



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,425	06/24/2003	William G. Pagan	RPS920030088US1	9632
47052	7590	01/29/2007		
SAWYER LAW GROUP LLP PO BOX 51418 PALO ALTO, CA 94303			EXAMINER NUNEZ, JORDANY	
			ART UNIT	PAPER NUMBER
			2179	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary**Application No.**

10/602,425

Applicant(s)

PAGAN, WILLIAM G.

Examiner

Jordany Núñez

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/24/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As to independent claim 12, the claimed invention is directed towards a "computer-readable medium" (line 1) that, as stated in the specification, comprises a "computer readable signal" (page 12, lines 10-16). A "computer readable signal" is not a process, machine, manufacture, nor composition of matter. Thus, the claimed invention is considered non-statutory.

Claims 23-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As to independent claim 23, the claimed invention does not recite any enabling hardware and therefore is read as software per-se. Software per-se is not a process, machine, manufacture, nor composition of matter. Thus, the claimed invention is considered non-statutory.

Claims 1-33 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Independent claims 1, 12, 23 recite steps (e.g., "integrating [...]", "allowing a user [...]") that do not produce a useful, concrete and tangible result. Data manipulation (e.g., "integrating [...]", "allowing a user [...]") is not a useful, concrete and tangible result. Furthermore, Examiner sees no physical transformation as a result of performing the steps recited. MPEP § 2106, "In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is 'useful, tangible, and concrete.'"

Any claim not specifically addressed is rejected based upon the rejection of the claim from which it depends.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Slaunwhite et al. (US20030090471, hereinafter Slaunwhite).

As to claims 1, 12, Slaunwhite shows:

A method comprising steps, and a computer-readable medium including a program including instructions, for providing a hot key corresponding to a particular function in a computer system, the computer system having a graphical user interface (GUI), the particular function for a context (abstract, lines 1-7), comprising:

integrating a hot key configuring function into the GUI such that a user can access the hot key configuring function from the context (page 3, paragraph [0043]);

and allowing a user to utilize the hot key configuring function in the context to map the hot key to the particular function (page 3, paragraph [0044]).

As to claims 2, 13, 24, Slaunwhite shows:

The method of claim 1 further comprising the step of:

accounting for ambiguities, if any, between the hot key (e.g., command item) and a pre-existing hot key (e.g., non-command item) (page 3, paragraph [0038]).

As to claims 3, 14, 25, Slaunwhite shows:

Art Unit: 2179

wherein the context includes a plurality of items in the GUI (page 2, paragraph [0036], lines 1-3), one of the plurality of items corresponding to the particular function (page 2, paragraph [0035], lines 1-5), wherein the computer system includes a mouse (page 2, paragraph [0027]), and wherein hot key configuring function integrating step further includes the steps of:

determining the plurality of items selectable in the context (page 2, paragraphs [0035] and [0036], lines 1-3);

and providing a mechanism for mapping at least one of the plurality of items to the hot key from the context (page 2, paragraph [0036], lines 3-8).

As to claims 4, 15, 26, Slaunwhite shows:

wherein the hot key configuring function integrating step further includes means for accounting for ambiguities, if any, between the hot key (e.g., command item) and a pre-existing hot key (e.g., non-command item) (page 3, paragraph [0038]).

As to claims 5, 16, 27, Slaunwhite shows:

wherein the user allowing step further includes the steps of:

allowing (e.g., not preventing) the user to select a key combination for the hot key (page 2, paragraph [0036], lines 3-8).

As to claims 6, 20, 28, Slaunwhite shows:

The method of claim 5 wherein the key combination includes a plurality of keys (page 2, paragraph [0036], lines 3-8).

As to claims 7, 17, 29, Slaunwhite shows:

The method of claim 5 wherein the key combination selecting step further includes the step of:

performing a pointing device action on a portion of the item (page 2, paragraph [0037]) (inherent to "user selects the item type from a list").

Art Unit: 2179

As to claims 8, 18, 30, Slaunwhite shows:

The method of claim 7 wherein the pointing device action includes clicking on a portion of a text of the item and wherein the portion of the text is assigned as a portion of the hot key (page 3, paragraph [0040], lines 1-8; page 1, paragraph [0005], lines 1-9)) (e.g., the user is able to "set focus on the non-command item when it is displayed", the non-command item being a drop-down listbox, or an edit box).

As to claims 9, 19, 31, Slaunwhite shows:

The method of claim 8 wherein the hot portion of the text is assigned as at least a portion of the hot key for the item (e.g., the non-command item has a value assigned by default, and this value is at least in portion text) (page 3, paragraph [0040], lines 1-8; page 1, paragraph [0005], lines 1-9)).

As to claims 10, 21, 32, Slaunwhite shows:

wherein the computer system further includes a pointing device (page 2, paragraph [0027]), wherein the context include a feature corresponding to the particular function (page 2, paragraph [0037]) (e.g., item type on a list) and wherein the user allowing step further includes the steps of:

allowing (e.g., not preventing) the user to hover the pointing device over the feature to indicate the particular function to which the hot key is to be mapped (page 2, paragraph [0037]) (inherent to "user selects the item type from a list");

allowing (e.g., not preventing) the user to select a key combination as the hot key (page 2, paragraph [0036], lines 3-8).

As to claims 11, 22, 33, Slaunwhite shows:

wherein the user allowing function further includes the steps of:

mapping the key combination to the particular function (page 3, paragraph [0044]).

As to claim 23, Slaunwhite shows:

Art Unit: 2179

A computer system (page 4, paragraph [0058]) comprising:
an application providing a context (figure 4) and having a particular function (e.g., zoom) available therein (page 3, paragraph [0050], lines 1-7);
a graphical user interface (GUI) (figure 4);
and a hot key configuring function integrated into the GUI (figure 1, element 100) such that a user can access the hot key configuring function from the context (abstract, lines 1-7), the integrated hot key configuring function allowing a user to utilize the hot key configuring function in the context to map the hot key to the particular function (page 3, paragraph [0044]).

References to specific columns, figures or lines should not be limiting in any way. The entire reference provides disclosure related to the claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

May	[U.S. 5973688]
Wang	[US7015898]
Williams et al	[US20040239637]
Numano	[US6934778]

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordany Núñez whose telephone number is (571)272-2753. The examiner can normally be reached on Monday Through Friday 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571)272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2179

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JN
1/19/2007



WEILUN LO
SUPERVISORY PATENT EXAMINER